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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,913	11/13/2001	Satoshi Gocho	1186.1020	6641

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,913

Applicant(s)

GOCHO ET AL.

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-26-04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1774

DETAILED ACTION

This Office Action is responsive to the amendment filed 03-26-04. Cancellation of claim 27 is acknowledged. The 112 rejection is withdrawn because Applicant cancelled the new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-26 and 28-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,284,337 to Lorimor et al. in view of USPN 5,800,950 to Hirao et al., JP 03118198 to Kijima et al., and USPN 6,111,696 to Allen et al. for reasons of record as previously set forth in Paper No. 6.

To the new limitation, “if the polarizing member is arranged at an observer side close to the latent image formation layer” is a description of a condition due to time constraints and not a positive recitation to the claim. Thus, the aforesaid phrase is not germane to patentability.

Response to Arguments

Applicant's arguments filed 03-26-04 have been fully considered but they are not persuasive.

Applicant argues instant claims 8, 20 and 31 to the shape of the polarizing member, further discussing the differences between circular and elliptical types and their effects on polarizing light. However, the polarizing member is not part of the claim, as it is not positively recited. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lorimor teaches a durable security laminate with a heat shrinkable layer. Lorimor's laminate comprises an emblem layer with liquid crystal polymers or pearlescent pigments such as titania. See col. 5, lines 1-15. Hirao teaches a recording element that is laminated and has the polymer, which is capable of forming a liquid crystal phase having a nematic or smectic molecular configuration. As previously set forth, the reason for obviousness would have been to modify the laminate of Lorimor to include liquid crystals arranged nematically or smectically as instant claims require because Hirao teaches such arrangement is conventional for liquid crystals as shown in Figures 9 and 10 for the purpose of providing optical ionization as taught by Hirao at col. 20, lines 1-30. Kijima was used to teach an additional optical layer and the thermotropic type of liquid crystalline polymer. Kijima teaches a card and image forming method having a metal reflecting layer (optical layer having light reflectivity), a liquid crystal polymer layer of a

Art Unit: 1774

thermotropic type, and polarizing film laminated to a card base. See Abstract. Figure 1 shows the optical layer on the latent image liquid crystal polymer layer (instant claim 4). As previously set forth, one would be motivated to provide a thermotropic type of liquid crystalline polymer and optical layer to the laminate of Lorimor since Kijima teaches the application of such layers are conventional enabling a card capability of preventing forgery and the liquid polymer provides the appropriate melting point as taught by Kijima in the Abstract. Applicant argues that a combination of such a large number of references (4), would constitute a hindsight approach. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Lorimor suggests adding additional optical layers and the specific liquid crystalline polymer is provided by Kijima in the Abstract and Figure 1. Hirao teaches the aforesaid arrangement is conventional for liquid crystals as shown in Figures 9 and 10. Applicant admits that the present invention teaches using a laminated composite that does not include a polarizing member but it simply uses a polarizing member. The mere "use" of a product is not afforded patentable weight. It has been held that a

Art Unit: 1774

recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

All references teach modifications to the Lorimor reference and Lorimor suggests the aforesaid modifications. Hence the 103 rejection is a valid obviousness rejection. A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Until the Applicant can show and prove any results that would not obvious, the rejection will stand. Conclusively, Applicant has not persuasively argued for reasons set forth above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1774

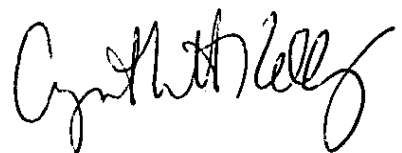
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus
Examiner
Art Unit 1774

June 8, 2004

A handwritten signature in black ink, appearing to read "Cynthia Kelly", is located in the bottom right corner of the page.